



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,718	04/04/2001	Yoji Furuya	36409-01100	3164
27171 7590 05/18/2007 MILBANK, TWEED, HADLEY & MCCLOY 1 CHASE MANHATTAN PLAZA NEW YORK, NY 10005-1413			EXAMINER POND, ROBERT M	
			ART UNIT 3625	PAPER NUMBER
			MAIL DATE 05/18/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/825,718

Applicant(s)

FURUYA, YOJI

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 49-53 and 55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 49-53 and 55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

The Applicant amended claims 49, 50, and 55. Claims 1-48, 54, and 56 are canceled. All pending claims 49-53 and 55 were examined in this final office necessitated by amended.

### ***Response to Arguments***

The Applicant amended claim language and based arguments on the amended claim language. Applicant's arguments filed 23 February 2007 have been fully considered but they are not persuasive. Stefik discloses printer security level and watermark are specified in the printer's identification certificate. This means of identification is used to guarantee the safety of the printed document.

The Examiner is suggesting the Applicant consider a telephone interview for further discussion pertaining to subject matter.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject

matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**1. Claims 49, 50, 53, and 55 are rejected under 35 USC 103(a) as being unpatentable over Stefik (US 6,233,684) in view of Kageyama (US 6,333,790).**

Stefik teaches problems pertaining to rights protection of printed digital works. Stefik teaches a trusted system and method of rendering digital works by a trusted printer connected to a trusted server over a network (i.e. second connection means; network or Internet) and further teaches the trusted printer connected to a user's personal computer (i.e. first connection means). Stefik further teaches:

- A determination step for determining whether a model of printer can guarantee safety of the image data; depositing a digital working into the repository is an indication that it is being placed into a controlled system that will protect the digital work (please see at least Fig. 5; col. 8, lines 4-25); determining in response to a request (see at least col. 6, lines 1-10); challenge-response protocol determines whether printer can protect image data (see at least col. 16, lines 58-63).
- A data transmission step of transmitting the image data to said printer, when the determination of said determining step indicates that the model of said printer can guarantee the safety.

security level and watermark are specified in the printer's identification certificate (see at least col. 13, lines 2-9). Although Stefik does not specifically disclose printer model, it would have been obvious to one of ordinary skill in the art at time the invention was made to rely upon or incorporate the use of printer model or model type as a means of printer identification.

wherein the printer includes:

- First connection means for connecting to a user device on a user side; connection between user's personal computer and printer trusted printing to an Internet printer wherein the publisher does not want digital delivery to be made to a consumer workstation (for printout), and therefore sends the digital work (e.g. digital book) directly to the Internet printer (see at least col. 9, lines 41-60); typical connection from user's desktop computer to printer serial port (see at least col. 14, lines 9-12).
- Second connection means for connecting to said supplier device via the Internet; as noted above, digital delivery is made directly to the printer via the Internet (see at least col. 9, lines 41-60). Please note: supporting disclosures pertaining to second connection means (see at least col. 16, line 15 through col. 18, line 5).
- Data reception means for receiving image data according to the transaction data, which included the identification of image data

from the supplier side via said second connection means; image data transferred to printer via second connection means (see at least (see at least col. 9, lines 41-60); please note: detail disclosure of second connection means (see at least col. 16, line 15 through col. 18, line 5).

- and printing means for printing the image data received by said data reception means; (see at least Fig. 3 (301); col. 7, line 10 through col. 8, line 38).

Stefik teaches all the above as noted under the 103(a) rejection and teaches a) having a first connection means between the user computer and printer, b) the user via user computer making a request to a server-managed repository to print a digital work, and c) the server-managed repository establishing a print session directly with the printer via the Internet (i.e. second connection means), but does not disclose request reception means for receiving transaction data from said user device via said first connection means nor notification means. Kageyama teaches a first computer connected to a printer (i.e. first connection means) and a second computer connected to the printer via a network (i.e. second connection means) whereby the first computer instructs the printer to print. Kageyama teaches the printer determining a condition that requires the printer to communicate directly with the second computer, providing information that identifies the printer and purpose of the direct communication (see at least

Art Unit: 3625

abstract; Fig. 1; col. 1-4). Since Stefik teaches communication means between the user computer and publisher, user computer and printer, and publisher directly to the printer, it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Stefik to disclose the printer initiating direct communication with a server after being instructed to print by the first computer as taught by Kageyama, in order address the obvious remaining option for communication between three communicating devices.

Pertaining to system claims 49, 50, and 53

Rejection of claims 49, 50, and 53 is based on the same rationale as noted above.

- 2. Claims 51 and 52 are rejected under 35 USC 103(a) as being unpatentable over unpatentable over Stefik (US 6,233,684) and Kageyama (US 6,333,790) as applied to claim 49, further in view of Rager (Paper #5, US 5,363,447).**

Stefik and Kageyama teach all the above as noted under the 103(a) rejection and teach a) storing charging information in memory, b) storing print data, and c) deleting information, but do not disclose deleting information upon detecting a power-off condition. Rager teaches erasing memory to maintain data security in the event that a device is tampered with or powered down (see at least col. 1, lines 64-67; col. 4, lines 37-49). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Stefik and Kageyama to include power-off detection and data deletion as

Art Unit: 3625

taught by Rager, in order to provide tamper-proof data protection of chargeable print data, and thereby attract data suppliers to the service.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Robert M. Pond', is positioned above the printed name.

Robert M. Pond  
Primary Examiner  
May 13, 2007